



REMARKS

Applicant notes the Examiner has withdrawn the rejections previously made of record.

The Examiner has now rejected claims 27-30 under 35 U.S.C. §112, 1st paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner states that claims 27-30 have the limitation "non-scored crease lines" and further states that the specification does not disclose that forming the fold regions by scoring is excluded from the types of processes to make the fold regions, and therefore, the limitation is considered new matter.

Applicant disagrees with this characterization of the claims. Specifically, Applicant directs the Examiners attention to page 5, lines 16-21, which disclose that the packaging laminate comprises "the same material layers but with crease lines according to the present invention. The packaging material 20 has been provided with fold indications by reducing, or preferably, eliminating the adhesive bonding strength between the core layer 11 and layer 12 laminated on the inside of the core layer along the fold indications." Turning now to page 6, lines 12-14, it is noted that "[t]he linear regions with reduced or eliminated adhesion thus constitute distinct fold indications in the packaging material without the packaging material having been deformed in any way beforehand." Thus, it is Applicant's position that the non-scored crease lines are, in fact, supported by the specification.

It is Applicant's position that other passages in the specification further support this interpretation. Specifically, on page 6 at lines 19-25, the specification provides as follows "[a]nother packaging laminate according to the invention may be crease-processed both by conventional mechanical deforming and by adhesion-reduction or adhesion-elimination between the layers in the fold regions. Such a "double-creased" packaging laminate achieves better defined folds and corners in the fold-formed

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packaging container and lower flexural resistance as compared with exclusively conventional mechanical deformation." It is Applicant position that the "conventional mechanical deforming" referred to in these passages is the conventional scored crease lines. As such, Applicant submits that the non-scored crease lines claimed in claims 27-30 are, in fact, supported by the disclosure. Accordingly, Applicant respectfully requests that the Examiner withdraw this basis for rejection of claims 27-30.

The Examiner has next rejected claims 14, 16, 27, 28 and 30 under 35 U.S.C. §103(a) as being unpatentable over Zinn, U.S. Patent No. 2,558,918. The Examiner characterizes Zinn as disclosing a lined carton comprising a cardboard blank adhesively attached to a liner except at regions adjacent to the crease. The Examiner notes that the lined carton is provided with a plurality of crease lines. The Examiner states that since the crease lines are not provided with adhesive, the bond strength of the crease line region is less than the bond strength for the non-creased regions which are provided with adhesive. This, the Examiner asserts, permits the liner to separate from the cardboard blank at the corners when the carton is folded.

The Examiner notes that Zinn fails to disclose the cardboard blank at the corners when the carton is folded.

The Examiner notes that Zinn fails to disclose the cardboard blank and liner are coextensive with one another but, concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the layers coextensive and that one of ordinary skill would be motivated to do so because it would make manufacturing the carton faster and ensure that the entire carton would be lined.

The Examiner then states that process limitations are given little weight or no-patentable weight and that the method of forming the product is not germane to the issue of patentability of the product itself. Next, the Examiner states that the determination of patentability for a product by process claim is based on the product itself and not the method of production and that if the product and the product by process claim is the same

or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

The Examiner next rejects claims 15 and 29 under 35 U.S.C. §103(a) as being unpatentable over Zinn in view of Skjelby. The Skjelby reference has been discussed in detail in prior correspondence presently of record. The Examiner asserts that Skjelby discloses a coated paperboard container and blank with a plurality of fold and non-fold regions and crease lines for some of the fold regions are treated with an adhesive that may be made of any suitable material such as wax-base material, and permits ease separation between the layers. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the adhesive material of Skjelby to the crease lines of Zinn because it would have helped the liner more easily separate from the cardboard blank at the corners.

Next, the Examiner rejects claim 17 under 35 U.S.C. §103(a) as being unpatentable over Zinn in view of Hecking, U.S. Patent No. 4,712,737 or Nagata, U.S. Patent No. 4,909,432. The Examiner cites Hecking and Nagata for their asserted disclosure of a carton comprising a paperboard lined aluminum foil and a thick paper lined with polyethylene, aluminum or the like, respectively. The Examiner concludes stating that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use polyethylene or the aluminum liner as suggested by Hecking or Nagata depending on the type of material to be container by the carton. Again, Applicant takes issue with the references cited by the Examiner and their characterization and combination. Specifically, Zinn fails to disclose first and second layers coextensive with one another. Rather, Zinn discloses what appears to be an inner layer adhered to an outer blank, extending only over a portion of the blank. As such, Zinn without questions fails to disclose the entirety of the claimed invention. To Zinn, however, the Examiner has combined the disclosure of Skjelby. As set forth above, Skjelby has been discussed at length in prior correspondence of record in the present application. Although Skjelby does appear to disclose a fully lined container, it is Applicant's position that there is

simply nothing that the Examiner has set forth that would suggest to one skilled in the art to make the claimed combination. Specifically, the prior art or record must somehow teach, motivate or suggest to one skilled in the art to make the combination. There is no such teaching motivation or suggestion in the prior art or record. The burden to show the teaching, motivation or suggestion, is on the Patent Office. It is not Applicant's burden to rebut a conclusion made by the Patent Office without any support for making the claimed combination. As such, it is Applicant's position that because the Examiner has failed to show the teaching, motivation or suggestion, that the present rejections, are, in fact, improper.

In fact, it is Applicant's position that the Examiner has made this rejection only with 20/20 hindsight. Applicant submits that without the claims in front of the Examiner, the Examiner would not have found any such "motivation". To this end, Applicant submits that it is only with impermissible hindsight that the Examiner has made the claimed combination. To this end, Applicant submits that the claims are in fact allowable over the art of record and respectfully and earnestly request that the Examiner withdraw the basis for rejection of the pending claims, and allow the application to move on to allowance and issue.

With respect to the Examiner's rejection as to the "processed limitations" Applicant submits that these are not, in fact processed limitations. Rather, Applicant has provided functional limitation describing the nature of the interaction of the first and second layers, to wit, when the layers are folded at the crease lines, the first and second layers separate from one another at the liner fold regions. Applicant submits that there is nothing "product-by-process" in this claim. Rather, it is merely functional limitation that is intended to provide an understanding of various structures and their interaction with each other. Thus, Applicant submits that the statements regarding product-by-process limitations are, likewise, improper and should be withdrawn as well.

As to the Examiner's rejection of claims 15, 17 and 29, Applicant submits that because the pending independent claims, namely, claims 14 and 27 are allowable over the art of record, these claims are allowable over the art or record for the same reason.

Applicant submits that the presently pending claims, namely, claims 14-17 and 27-30 are, in fact, allowable over the art or record and respectfully and earnestly solicits early indication of same.

Applicant believes that there is no fee due in connection with the present Response. If, however, there is a fee due, Applicant requests that this paper constitute any necessary petition and authorizes the Commissioner to charge any underpayment, or credit any overpayment, to Deposit Account No. 23-0920. A duplicate copy of this sheet is enclosed.

Should the Examiner believe that a telephone interview would expedite addressing any formal matters that may retain, it is respectfully requested that the undersigned be contacted.

Respectfully submitted,

**WELSH & KATZ, LTD.**

By: 

Mitchell J. Weinstein  
Registration No. 37,963

Dated: March 25, 2002  
**WELSH & KATZ, LTD.**  
120 South Riverside Plaza, 22<sup>nd</sup> Floor  
Chicago, Illinois 60606  
Telephone: (312) 655-1500  
Facsimile: (312) 655-1501